

**REMARKS**

The Official Action dated November 29, 2002 has been carefully considered. Accordingly, the present amendment, along with the following remarks are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

By the present Amendment, claim 1 is amended to include limitations from previous dependent claim 27. A Version With Markings Showing Changes Made is attached. It is believed that these changes do not involve any introduction of new matter, and do not raise any new issues subsequent to final rejection, whereby entry is believed to be in order and is respectfully requested.

Claims 1-12 and 27-31 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,306,435 (Ishikawa et al.). Specifically, the Examiner asserts that Ishikawa teaches a composition for treating leather such as shoes. Further, the Examiner asserts that this composition comprises ingredients such as carboxymethylcellulose and nonionic surfactants, and is used for cleaning purposes such as cleaning dirt. The Examiner concludes that it would have been obvious to one skilled in the art to make such a composition effective for treating and cleaning shoes by optimizing the ingredients to obtain the requisite effective amounts.

This rejection is traversed and reconsideration is respectfully requested. More particularly, according to claim 1, the invention is directed to a pre-treating composition for shoes, comprising a polymeric soil release agent in an amount effective to provide soil release benefit, and a spreading agent. Claims 28 and 29 further define the amount of polymeric soil release agent in the pre-treating composition as from about 0.1 to about 95% (claim 28) and as from about 0.1 to about 10% (claim 29).

Ishikawa teaches a composition for treating the raw materials from which articles such as shoes, handbags, clothing, and the like, are manufactured. The Ishikawa treatment comprises: a water-soluble or water-dispersible polyurethane; a salt of Al, Cr or Zr, a surfactant comprising at least one nonionic surfactant which is an ethylene oxide adduct, and auxiliary ingredients including, for example, dispersants and cross-linking agents, and defined as those conventionally used in leather, fur and fibrous treating compositions (col. 3, lines 62-66). The Ishikawa composition is intended for application to leather, fur pelt or fibrous material prior to the assembly of an upstream article. It is intended for use as a sealant and shrink-proofing agent (col. 1, lines 8-9; col. 2, lines 36-49).

Applicants respectfully submit that the Examiner's assertion that Ishikawa teaches carboxymethylcellulose (CMC) as an ingredient of the treatment solution is in error. The Ishikawa disclosure contains over 90 exemplar formulations of the inventive treatment composition, none of which comprise CMC or any polysaccharide. None of the Ishikawa independent or dependent claims mention a soil release agent, polysaccharide, or CMC. The Examiner cites col. 4, line 48 for this assertion. The Ishikawa specification at Col. 4, lines 21-25 introduces the subsequent paragraphs thusly: "[t]he water-soluble and/or water-dispersible polyurethane constituting ingredient a) of the invention may be produced by any of the methods mentioned below." Clearly, the subsequent methods being disclosed are not treating methods, and do not employ the treating composition, but are means to procure an ingredient for the treating composition. Method 2, under which CMC is mentioned, describes a means for providing the water-dispersible polyurethane of the treating composition. One of the method 2 steps involves the use of a surfactant as an emulsifier, and the use of an emulsion stabilizer. CMC is mentioned merely within the context of being one of an enumerated list of typical emulsion stabilizers known in the polymer arts. Ishikawa does not contemplate CMC as an ingredient of the treating composition in any amount, or for any

purpose. Further, even if CMC were selected as the emulsion stabilizer during the production of Ishikawa's polyurethane ingredient a), Applicants submit that only a residual, trace amount of CMC, if any, would be present in the final treatment solution. Finally, the Ishikawa specification fails to include CMC, or any polysaccharide, in its list of suitable auxiliary ingredients (cols. 8-9). Thus, the Ishikawa compositions do not comprise an amount of CMC effective to function as the soil release agent of the present composition, as required by present independent claim 1.

"To establish a *prima facie* case of obviousness, three basic requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference...Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §2143.

Applicants submit that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness. The Ishikawa reference does not teach or suggest all the claim limitations of the instant invention since it fails to disclose a pre-treating composition comprising a polymeric soil release agent, particularly in combination with a spreading agent. In fact, Ishikawa provides a prodigious 91 exemplar treatment compositions, none of which list a soil release agent as defined by the present specification, and none of which include CMC, or any polysaccharide as an ingredient in any amount.

In summary, Applicants respectfully submit that the Examiner has failed to meet their burden of establishing a *prima facie* case of obviousness based on the Ishikawa reference. Hence, the rejection under 35 U.S.C. §103 has been overcome, and reconsideration is requested.

It is believed that the above represents a complete response to the Examiner's rejection under 35 U.S.C. §103, and places the present application in condition for allowance. Reconsideration and an early allowance are respectfully requested. In the event that the present application is still not in condition for allowance, entry of the present amendment for purposes of appeal is requested.

Respectfully submitted,



Holly D. Kozlowski  
Registration No. 30,468  
Attorney for Applicants  
DINSMORE & SHOHL LLP  
1900 Chemed Center  
255 East Fifth Street  
Cincinnati, Ohio 45202  
(513) 977-8568

**VERSION WITH MARKINGS SHOWING CHANGES MADE**

Claim 1 is amended as follows:

1. A pre-treating composition for shoes comprising a polymeric soil release agent in an amount effective to provide soil release benefit, and a spreading agent.

861075v1